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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,232	07/22/2003	Nagy Adly Habib	380048-97	8627

7590 10/05/2006

Attn: Barbara A. Wrigley  
OPPENHEIMER WOLFF & DONNELLY LLP  
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Minneapolis, MN 55402

EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,232

Applicant(s)

HABIB ET AL.

Examiner

Aaron Roane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/9/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,628,990. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference in the claims is well known in the art as disclosed by Applicant.

### *Election/Restrictions*

Applicant's election with traverse of specie #2 in the reply filed on 7/14/2006 is acknowledged. The traversal is on the ground(s) that "all three species have clear overlap in scope and are not 'clearly patentable' over each other." The examiner highlights the 3<sup>rd</sup> paragraph on page 3 of the previous requirement for an election of species wherein it states:

*Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.*

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Therefore the examiner withdraws the previous requirement and if the examiner finds one of the inventions unpatentable over the prior art, the evidence or Applicant's admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 1-18 will be examined.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al.

(USPN 5,472,441) in view of Edwards (USPN 5,836,906) in still further view of Swanson (USPN 6,267,760).

Regarding claims 1, 3, 5, 6, 8, 9 and 12-14, Edwards et al. disclose a device and method of treating tissue, the method comprising inserting a device into the tissue or organ to be treated (abstract), the device comprising an applicator (222) having a source of RF power (not shown), the applicator being in the form of a waveguide (inherent) for EM transmission extending to one face of the applicator, and an array of parallel needles (215-219) in a straight row and of the same length arranged so as to extend from said one face of the applicator; positioning the array of needles so that one face of the applicator

and the array of needles define a volume of the tissue to be treated, the array of needles serving to confine the microwave energy field formed within the applicator; and applying energy confined by the needles to the volume of the tissue to be treated, see 1-13 and more particularly col. 2, col.6-8 and col. 13, lines 53-60 and figures 1-16 and figure 16 in particular. Edwards et al. fail to explicitly disclose that the method is used to reduce bleeding and/or blood loss. Edwards et al. fail to explicitly disclose use of microwave but do disclose the known use on microwave energy to treat the tissue with the use of a cooling fluid to prevent undue damage, see col. 1, line 65 through col. 2, line 25.

Additionally, Edwards et al. (Edwards I) fail to disclose to explicitly disclose the step of making an incision into the tissue which has been heated. Applicant discloses on page 1, lines 10-15 that it is well known that heating tissue 20°C – 30°C greatly reduces blood flow. This great reduction in blood flow provides the inherent control of blood loss when tissue is heated. Edwards (Edwards II) discloses a tissue heating device having retractable needles (12) and teaches the alternative/equivalent energy delivery of microwave with cooling means and RF, see col. 1-7 and particularly col. 7, lines 28-38 and figures 1-6. Finally, Swanson discloses a device and method of heating tissue and teaches making an incision in the treated tissue after the heating step in order to reduce blood loss and verify the coagulation depth in the treated tissue, see col. 8, lines 33-41. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Edwards et al. (Edwards I), as is well known in the art, that blood flow in tissue is greatly reduced if the tissue is heated 20°C – 30°C, as further taught by Edwards (Edwards II), to use microwave energy as an alternate means

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of heating tissue, and as finally taught by Swanson, to make an incision in the heated tissue in order to reduce blood loss and verify the coagulation depth in the treated tissue.

Regarding claims 2 and 4, Edwards et al. (Edwards I) in view of Edwards (Edwards II) in further view of Swanson disclose the claimed invention, see Edwards II col. 6-9.

Regarding claims 15-18, Edwards et al. (Edwards I) in view of Edwards (Edwards II) in further view of Swanson disclose the claimed invention, see Edwards et al. col. 6-14 and figure 16.

Claims 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. (USPN 5,472,441) in view of Edwards (USPN 5,836,906) in further view of Swanson (USPN 6,267,760) as applied to claims 3 and 6 above, and further in view of admitted prior art.

Regarding claims 7, 10 and 11, Edwards et al. (Edwards I) in view of Edwards (Edwards II) in further view of Swanson disclose the claimed invention in further view of Applicant's admission on the record that the claimed species are no patentably distinct as noted above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R. *A.R.*  
September 22, 2006

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER